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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,722	04/21/2006	Shintaro Hikasa	289279US0PCT	4366
22850	7590	09/18/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
ROLLAND, ALEX A				
ART UNIT		PAPER NUMBER		
1792				
NOTIFICATION DATE		DELIVERY MODE		
09/18/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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### Office Action Summary

**Application No.**

10/576,722

**Applicant(s)**

HIKASA ET AL.

**Examiner**

ALEX ROLLAND

**Art Unit**

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of group II, claims 8-20 in the reply filed on 8/17/09 is acknowledged. The traversal is on the ground(s) that consideration of the contribution of each invention, as a whole, and contents of the claims interpreted in light of the description in alleging the lack of a special technical feature is not present. This is not found persuasive because the entire invention was considered and the claims were interpreted in light of the specification. The common technical feature remains the step for floating a transfer sheet comprising PVA on the surface of an aqueous solution and this step is found in Marui et al.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 8-11, 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4231829 to Marui et al in view of US 3316190 to Suzumura et al.

Claim 8:

Marui teaches a process of transferring a pattern printed on a thin film of polyvinyl alcohol resin to a surface of an object by pressing the object to the thin film floated on the surface of the water (abstract). The film comprises 100 parts PVA polymer and .2 parts non-ionic surface active agent (claimed "surfactant") (col. 9, lines 41-49).

Additionally, Marui teaches that the extension rate of the film is at most about 60% (col. 5, lines 62-67). Marui is unclear as to the exact non-ionic surface active agent used. However, Suzumura teaches a cold water-soluble PVA film that is non-sticky at high humidity (col. 1, lines 10-14) and that surface active agents improve the cold water-solubility and reduces stickiness (col. 1, lines 51-67) wherein typical nonionic surface active agents include ethylene oxide adducts of lauryl alcohol (col. 2, lines 20-22). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use ethylene oxide adducts of lauryl alcohol as the non-ionic surface agent of Marui because Suzumura states that it is a suitable surface active agent for achieving the goal of improved cold water solubility and reduced stickiness. Additionally, the extension ratio under any conditions and the surface tension of the surfactant under any conditions are found to be properties of the claimed composition. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). Additionally, "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Claim 9:

The thin film additionally contains 10 parts of glycerin (Marui, col. 9, line 46) which is a plasticizer as defined by Applicant's specification (pg. 23).

Claim 10:

The thin film can additionally contain up to 50% starch (Marui, col. 3, lines 38-50) but preferably 10 parts (Marui, col. 8, lines 14-15).

Claim 11:

The thin film contains .5 parts boric acid (Marui, col. 9, line 47).

Claim 14:

The film thickness is .035 mm which converts to 35 micrometers (Marui, col. 9, lines 51-52).

Claims 19-20:

A pattern is printed onto the thin film and may be carried out by any known printing process (Marui, col. 5, lines 17-18).

Claims 13, 15-18:

These limitations are determined to be properties of the claimed composition. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima

facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). Additionally, "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 4231829 to Marui et al and US 3316190 to Suzumura et al in view of US 3220992 to Smyser et al.

Marui and Suzumura are discussed above but fail to teach the moisture content of the dried film. However, Smyser teaches a PVA film and a method for preparing a PVA film (col. 1, lines 10-15) wherein the slurring and solubility characteristics of the PVA may be improved (col. 1, lines 57-60) by controlling the moisture content between 2% and 4% (col. 2, lines 28-38). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to produce the film of Marui and Suzumura with the moisture content of Smyser because Smyser states that doing so improves the slurring and solubility characteristics of the PVA.

### ***Conclusion***

8. No Claims are allowed. All pending claims are rejected for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEX ROLLAND whose telephone number is (571)270-5355. The examiner can normally be reached on Monday through Friday, 9:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Cleveland can be reached on (571)272-1418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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/Michael Cleveland/  
Supervisory Patent Examiner, Art Unit 1792